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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,596	05/31/2001	Tsutomu Masuko	Q61608	7102
7590 12/30/2003 SUGHRUE, MION, ZINN MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213			EXAMINER LISH, PETER J	
			ART UNIT 1754	PAPER NUMBER
DATE MAILED: 12/30/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/867,596	<b>Applicant(s)</b> MASUKO ET AL.	
	<b>Examiner</b> Peter J Lish	<b>Art Unit</b> 1754	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 21-26.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's arguments filed 11/21/03 have been fully considered but they are not persuasive.

Applicant argues that there is no motivation to combine because the stated equivalency of boric acid and boron carbide for their use as graphitization promoters is not correct, as demonstrated by the present application. The applicant's discovery that the use of one may achieve slightly different results than the use of the other does not alter the teaching of the prior art, which teaches the interchangeable use of either in order to perform the required graphitization promotion. Applicant additionally argues that the two boron compounds are not equivalent, as evidenced by their different solubilities, however, their equivalency with respect to solubility is not a concern, the equivalency that is relied upon is their ability to promote graphitization, as taught in the prior art.

Applicant argues that the examples of the present application show the use of boron carbide ground to a specific particle size, which is not shown in the prior art. First, the effect of the particle size of the boron carbide on the graphite product is not shown. Furthermore, while not explicitly taught by the references, it would have been obvious to one of ordinary skill at the time of invention to provide the boron carbide in small particles in order to ensure a uniform graphitization, especially when using small carbon particles, and in order to efficiently utilize the promoter.

Applicant argues that the references do not teach the use of a temperature high enough to achieve a  $C_o$  spacing of 0.680 nm, specifically a temperature of at least 2500 °C. However, both references teach temperatures that fulfill this requirement. JP '351 teaches temperatures as high

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as 2500 °C, while JP '813 teaches temperatures as high as 2800 °C. While the prior art does not show any examples which utilize this higher temperature range, and thus result in the claimed C<sub>0</sub> spacing, no difference is seen in the processes of the prior art and that of the instantly claimed invention. It thereby is expected that the processes of the prior art produce a graphite product equivalent to that claimed.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Lish whose telephone number is 571-272-1354. The examiner can normally be reached on 9:00-6:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PL



STUART L. HENDRICKSON  
PRIMARY EXAMINER